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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,400	02/11/2004	John Snyder	XAW-0302	2389

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LAW OFFICE OF DALE B. HALLING, LLC
655 SOUTHPOINTE COURT, SUITE 100
COLORADO SPRINGS, CO 80906

EXAMINER

VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/776,400	SNYDER, JOHN	
	Examiner	Art Unit	
	Gregory J. Vaughn	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Action Background

1. This action is responsive to the applicant's amendment filed on 5/22/2006.
2. Applicant has amended claims 8 and 9.
3. Claims 1-21 are pending in the case, claims 1, 14 and 19 are independent claims.
4. Examiner's rejection of claims 8 and 9, made under 35 USC 112 in the *Claim Rejections – 35 USC 112* section of the previous office action (dated 4/7/2006) is withdrawn in view of the amended claims.
5. Applicant has amended the specification in response to the objections cited by the examiner in the *Specification* section of the previous office action (dated 4/7/2006). Applicant's amendment has addressed one of the objections previously made, and therefore, in view of the amendment, one of the objections to the specification is withdrawn. The withdrawn objection is: *"The disclosure recites "Lines 64 through 70" (page 6, line 27). Figure 5 includes only reference signs 64, 66 and 70".*

Drawings

6. The drawings remain objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:

- “60” in Figure 5.

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

7. The disclosure remains objected to because of the following informalities:
- The disclosure recites “*transformer document 22*” (page 5, line 25). Reference sign 22 of Figure 2 is directed toward a “*Transformer Program*”.
 - The disclosure recites “*XML system 34*” (page 6, line 6). Reference sign 34 of Figure 2 is directed toward a “*XML Stream*”.
 - The disclosure fails to disclose those reference signs listed in paragraph 6 above, which are shown in the drawings.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

9. Claims 1-21 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

10. **Regarding claims 1-21**, the claimed invention fails to produce a useful, concrete or tangible result. The claimed invention as a whole must accomplish a practical application. That is, it must produce a *"useful, concrete and tangible result."* *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. (See MPEP 2106.) Usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also *Schrader*, 22 F.3d at 295, 30 USPQ2d at 1459.

Applicant's invention is directed toward converting a text document into an XML document. Applicant's claims include the steps taken to manipulate (i.e.

Art Unit: 2178

convert) the nonfunctional descriptive material (i.e. the text document and the XML document), but fail to claim a significant functionality or practical application for the resultant XML document.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."

12. Claims 1-21 remain rejected under 35 U.S.C. 102(e) as being anticipated by Ye et al. US Patent Publication 2004/0083242, filed 10/20/2003, published 4/29/2004 (hereinafter Ye).
13. **Regarding independent claim 1**, Ye discloses converting an input text document into an XML document. Ye recites: *"The prior technologies for locating and transforming the data in a data file includes the XML Converter developed by the Unidex company. The XML Converter transforms the data*

Art Unit: 2178

in the data file having simple and delimited format" (paragraph 5). Ye discloses the resultant XML document does not contain every element that was in the input document. Ye recites: *"when the type of the data unit is not "Text", selecting a different data unit as the location reference for the data unit"* (paragraphs 17-18).

14. **Regarding dependent claims 2 and 3**, Ye discloses the input document as structured and semi-structured text documents. Ye recites: *"the invention has an advantage of being capable to transform data in the data files having various structures"* (paragraph 76).

15. **Regarding dependent claim 4**, Ye discloses the input document with at least two formats. Ye recites: *"in order to exchange data, it is firstly needed to understand, analyze and process the original data having different formats"* (paragraph 4).

16. **Regarding dependent claims 5-7**, Ye discloses the use of a field separator in the text document (claim 5), wherein the separator is a comma (claim 6) or a regular expression (claim 7). Ye recites: *"For example, it requires the data file to be processed must consist of records, where each record is a sequence of fields. The records and the fields are delimited by separators. The fields that are not delimited must have fixed length"* (paragraph 5). See also the text input document shown in Figure 4, where some of the input text is delimited by commas.

17. **Regarding dependent claim 8**, Ye discloses a match command for the text conversion. Ye recites: *"the above prior art, however, can only apply in specific application environments, and provide the key words matching or semantic analysis"* (paragraph 10).
18. **Regarding dependent claim 9**, Ye discloses an XML tree hierarchy. Ye discloses generating an XML document from an input stream, as described above. XML documents are processed by a parsing process that inherently builds a tree hierarchy structure.
19. **Regarding dependent claims 10 and 11**, Ye discloses the input as streaming text (claim 10) and the output as streaming XML (claim 11). Ye recites: *"It will be understandable that the persons in the art may employ any kinds of software and/or hardware to implement the function of each of the units in the data transforming device according to the invention. For example, the known computer, Web server, network and/or the software running in these facilities may implement the invention"* (paragraph 184).
20. **Regarding dependent claim 12**, Ye discloses a wizard that has a number of queries that are used to define the transformer program. Ye recites: *"the invention has another advantage of enabling a user to flexibly set the extraction rule and output rule on the original data when necessary"* (paragraph 77).

Art Unit: 2178

21. **Regarding dependent claim 13**, Ye discloses the input is from a legacy system. Ye recites: "the specialized data transformation tool is developed for a particular application system, in order to transform an original data into an objective data" (paragraph 3).
22. **Regarding claims 14-18 and 19-21**, the claims are directed toward a process and a system for the system of claims 1-13 and are rejected using the same rationale.

Response to Arguments

23. Applicant's arguments filed 5/22/2006 have been fully considered but they are not persuasive.
24. In response to the examiner's objections to the drawings of the originally filed specification, the applicant states: "*Reference numeral 60 is discussed on page 6, line 25*" (page 6, second paragraph, of the response filed 5/22/2006). The quoted line of the specification reads: "*Line 58 tells the computer to select only records that have the category 60 (see FIG. 3) of the customer.*" Applicant's Figure 3 clearly uses reference sign 60 to designate a "category" feature. The use of the reference sign "60" at line 25 of page 6 of the specification is clearly directed toward Figure 3. Applicant's Figure 5 uses reference sign 60 to designate a line of program code. Staring at line 13, of page 6, of the originally file specification, applicant is describing the inventive process in terms of the steps related to the program code shown. The

Art Unit: 2178

applicant states: "*line 48 defines the output*" (line 13), "*Line 50 uses the match*" (line 13), "*Line 51 uses the variable*" (line 16), "*Line 52 is a command*" (line 16) etc. The examiner maintains the drawing objection because the specification fails to mention or describe reference sign 60 used in Figure 5.

Furthermore, the use of reference sign 60 in both Figures 3 and 5 to designate different features of one invention fails to comply with 37 CFR 1.84(p)(4). Reference sign 60 is used to designate an element of a list in Figure 3, and used to designate a line of program code in Figure 5. The examiner suggests removing reference sign 60 from Figure 5 to resolve this issue.

25. In response to the examiner's objections to the originally filed specification, the applicant recites: "*the transformer program is a transformer document*" (page 6, third paragraph, of the response filed 5/22/2006). Figure 2 is a block diagram, where reference sign 22 is used to designate a block with the label "*Transformer Program*". The disclosure recites "*transformer document 22*" (page 5, line 25). Applicant may amend either the specification or the drawings to overcome this objection.

26. In response to the examiner's objections to the originally filed specification, the applicant recites: "*the specification states the "output may be a streamed XML 34 or an XML system."* This is correct and consistent" (page 6, fourth paragraph, of the response filed 5/22/2006). Figure 2 is a block diagram, where reference sign 34 is used to designate a block with the

Art Unit: 2178

label "XML Stream". The disclosure recites "XML system 34" (page 6, line 6). Applicant may amend either the specification or the drawings to overcome this objection.

27. In response to the examiner's rejection related to 35 USC 101, the applicant states: "*The absurdity of the examiner's suggestion that the present application is non-statutory is beyond description ... This rejection is arbitrary and capricious and wastes the applicant's and PTO's resources*" (page 6, last paragraph of the response filed 5/22/2006). This rejection was made based upon the patenting guidelines and rules as set forth in the MPEP. Applicant states a useful result of the invention as: "*The tangible result is to have data in a first format converted to a second more useful format*" (page 6, last paragraph of the response filed 5/22/2006). The claimed invention as a whole must accomplish a practical application. That is, it must produce a "*useful, concrete and tangible result.*" *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. (See MPEP 2106.) Usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Applicant has failed to claim what the second format is useful for. On page 1 of the originally filed specification, applicant suggests some uses for the invention as: "*transferring business data between suppliers and customers*" and "*for these legacy systems to share information*". The 35 USC 101 rejection, as restated herein, is maintained.

28. **Regarding claim 1**, the applicant states: *"There is no discussion in Ye as to whether the Unidex system used executable statements. Thus the examiner is just speculating"* (page 7, second paragraph of the response filed 5/22/2006). Applicant is directed to the rejection of claim 1, as restated above. Ye is clearly directed toward *"computer data processing"* (see page 1, paragraph 1 of Ye). Computers inherently use executable statements to control the operation of the computing machine. Furthermore, Ye discloses the use of executable statements (see the program code listings shown after paragraphs 121 and 157 in Ye).

Also regarding claim 1, the applicant states: *"the claim requires that the XML document not contain every element that was in the input text. Again Ye does not discuss this. As a result the examiner is just speculating"* (page 7, second paragraph, of the response filed 5/22/2006). Applicant is directed to the rejection of claim 1, as restated above. Ye's invention is directed toward locating and transforming data (see the publication title). Transforming a data file inherently includes transforming at least one element to some other element, and the resultant file would therefore *"not contain every element that was in the input text"*. Ye is transforming data in the data files (see paragraph 11). Ye discloses one condition for transforming data in paragraphs 17 and 18 (mentioned in the rejection above). The complete transformation process is described in paragraphs 14-23. Ye further describes other transforming processes as prior art, where the resultant file does not contain every element of the input file. See paragraph 5 of Ye, where the prior art transforms a data

Art Unit: 2178

file consisting of a sequence of fields, where the fields are delimited by separators. As is well known in the art, after this file is transformed, the separators are removed.

29. **Regarding claim 8**, applicant states: "*There is no description of a "match command" that allows actions if a match is not found*" (page 7, fourth paragraph of the response filed 5/22/2006). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "*allow actions if a match is not found*") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

30. **Regarding claim 9**, applicant states: "*the conversion program could be written in C commands that do not have a tree structure*" (page 7, fifth paragraph of the response filed 5/22/2006). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "*written in C commands*") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Art Unit: 2178

31. **Regarding claim 10**, applicant states: *"Not all conversions systems are capable of handling streaming data and there is no suggestion in Ye that he can handle streaming data"* (page 7, sixth paragraph of the response filed 5/22/2006). A review of the originally filed specification fails to establish a definitive definition for *"streaming data"*. On page 5, at lines 6-7, the specification states: *"The transformer program 14 converts a text document 16 or text stream into an XML file 18 or XML stream."* Based upon this statement, the examiner concludes that applicant establishes that a text document is equivalent to a text stream and a XML file is equivalent to an XML stream.
32. **Regarding claim 12**, applicant states: *"this paragraph does not discuss a transformer program or a wizard to help setup the transformer program"* (page 7, eighth paragraph, of the response filed 5/22/2006). Applicant is directed to the rejection of claim 12 as restated above. Claim 12 requires *"a wizard that has a number of queries that are used to defined the transformer programs."* Ye recites: *"enabling a user to flexibly set the extraction rule and output rule on the original data"* (page 3, paragraph 77). The examiner contends that *"set the extraction rule and output rule on the original data"* is the same as *"queries that are used to defined the transformer programs"*.
33. The balance of applicant's arguments is directed toward substantially the same arguments as those addressed above.

Conclusion

34. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



STEPHEN HONG
PATENT EXAMINER

Gregory J. Vaughn
Patent Examiner
July 26, 2006